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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,249	06/02/2000	Seishiro Yoshioka	35.C5745 CIP/C2/D2/REI	6842

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EXAMINER

RAMSEY, KENNETH J

ART UNIT PAPER NUMBER

2879

DATE MAILED: 03/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/587,249

Applicant(s)

YOSHIOKA ET AL.

Examiner

Kenneth J. Ramsey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8, 9, 11, 12, 15, 16, 18-23, 26-28, 31-43, 45 and 49-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 9, 11, 12, 15, 16, 18-23, 26-28, 31-43, 45 and 49-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_.

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1. The following is to complete the Office action of February 12, 2003 which was noted to be sent without pages 6-7 of the action. Applicant has been notified that the period for response has been reset to begin with the date of this action.
2. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed since applicant has made changes to the specification, claims or drawings subsequent to the date, March 13, 2002, of the most current reissue declaration in this application.

Claims 1-6, 8, 9, 11, 12, 15, 16, 18-23, 26-28, 31-43, 45 and 49-62 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

#### Recapture

The examiner has appended section MPEP 1412.02 to this Office action. Recapture is still applicable based upon this section of the MPEP which is deemed to follow the current case law as set forth therein.

Claims 58 is rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon

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which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

All of the patent claims were amended from their original form or distinguished from the prior art as set forth in either paragraph A or paragraph B, page 3 of the last office action:

A. Claim 141 was argued to be patentable over the patent to van Gorkom because "By contrast, in claims 141-143 of the present invention it is the fine particles between the electrodes that is the goal of the present invention. Whereas injected ions act as independent atoms [Gorkon et al, page 36, line 11], **the dispersed fine particles are bulky in nature** and do not act as individual atoms. This argument references the following language in claim 141: "**dispersing fine particles between said electrodes**".

B. Claims 137 and 144 were amended to overcome rejection thereof by the addition of the following language "**forming electrodes opposed to each on a**

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**substrate; forming between the electrodes an insulating layer in which fine particles are completely exposed; and etching the insulating layer so as to partially expose the fine particles"** . Subsequently, the examiner required the applicant to add **"and in contact therewith"** to each claim after "between the electrodes".

Thus recapture is present since any claim that does not contain either the "A" limitations or the "B" limitations is broader in an aspect relating to the surrender of claim scope. An argument that certain subject matter was not claimed and therefore in the parent application and therefore could not have been surrendered misses the point. Such newly claimed matter can be claimed only if it does not impermissibly recapture the aspects that were surrendered. Applicants argue that their argument to distinguish Claim 141, merely distinguished the prior art process which dispersed ions into the emissive layer and thus only that prior art process was surrendered. Even if this was true since none of the claims preclude the dispersing of ions into the emissive layer applicant has recaptured surrendered subject matter. However, the test of surrendered subject matter involves which limitations of the claims were relied upon to distinguish applicants claims from the prior art, not what is taught in one or more of the prior art references. See e.g. *Pannu*, 258 F.3d 1366 at 1372, 59 USPQ 2d 1597.

" Pannu argued to the examiner, 'no such particular shape is disclosed by the lenses of either Shearing or Lindstrom. In fact, Shearing teaches away from the concept of a continuous substantially circular arc supporting strand ... [and] the Lindstrom lens illustrates a supporting strand with a somewhat irregular, elliptical shape.' The addition of the 'continuous, substantially

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circular arc' limitation to claim 16 and the statements made by Pannu to the examiner during prosecution of the '855 patent limited the claim to exclude an interpretation that did not include a continuous, substantially circular arc." (underlining added)

The court considered the claim limitation relied upon by the applicant to distinguish their claims from the prior art, not the content of the cited prior art, as defining the subject matter that was surrendered. Since the rejected claims do not contain either of the limitations that were relied upon to secure a patent, applicant has recaptured surrendered subject matter since the broadness (i.e., scope) of those claims extends into the domain that was surrendered in order to obtain a patent. The only possible issue is whether or not the recapture is permissible (test 3 under *Pannu* 258 F3d 1366).

Applicants argue that the recapture is permissible per the case law, e.g. *Pannu*, 258 F.3d at 1372 and *Hester* 142 F.3d at 1482-1483. The examiner agrees with the case of *Hester* that where claims are broadened in aspects related to the surrendered subject matter but are materially narrowed in other overlooked aspects of the invention, that the recapture rule can be avoided. See *Hester* 46 USPQ2d 1641 at 1650:

"The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects. [5] However, this is not such a case. The asserted reissue claims are not materially narrower, despite Hester's arguments to the contrary. Hester argues that the claims are materially narrower by the addition of the 'spiral conveyance path' and 'high humidity steam' limitations. The term 'high humidity steam' is included in each of the asserted reissue claims except reissue claim 30 of the '259 reissue patent. However, the term 'high humidity steam' is actually the same as or broader than the limitation in original claim 1 that this term replaced. Original claim 1 specifies a steam atmosphere, 'at near 100% humidity 100 degrees C. and a pressure above atmospheric.' '047 patent, col. 6, ll. 3-4. Hester concedes that the term 'high humidity steam' is not narrower than this limitation in original claim 1. In fact, with respect to the claim construction issue, Hester argues that the limitation in original claim 1 is but one example of 'high humidity steam.' Accordingly, the use of the term 'high humidity steam' does not save the reissue claims from the recapture rule. "

The examiner agrees that the limitations "Pd", "carbon", "SiO2", relating to the specific material of the dispersed layer of patent claim 3, and the limitation (step like structure" relating to the shape of the dispersed layer of patent claim 3 as found in each

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of the allowed claims are material features of the claimed invention relating to the surrendered subject matter that were overlooked by applicants. These limitations serve to avoid the recapture rule. Thus the claims that recite these features have been allowed. However, the limitation relating to the size of the particles merely reflects the term "fine particles" as found in patent claim 3 and a single "metal particle" cannot have been overlooked or deemed a further limitation. Moreover, this is not a material difference since Smith "3,611,077" discloses particles (droplets) in a one micron layer of semiconductor which obviously fall in the range of the claim.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (3,611,077). The particles (droplets) of Smith clearly must be of the recited size since

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the layer is of the order of a micron thick (column 2, line 25), hence a size larger than several micrometers would not be feasible and the particles are deemed greater than several tens of angstroms since smaller particles would not be so fine as not to be called "small droplets" as in column (2, line 45).

6. Claims 1-6, 8, 9, 11, 12, 15, 16, 18-23, 26-28, 31-43, 45, 49-57 and 59-62 would be allowed if the supplemental reissue declaration is submitted.

#### Action Made Final

1. Applicants' amendments to the claims necessitated the new grounds of rejection herein. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

#### Directions for Responses

Any formal response to this communication should be directed to examiner Kenneth Ramsey, Art Unit 2879, and either

faxed to: 703-872-9319; or mailed to: Box AF

Assistant Commissioner For Patents  
Washington, D.C. 20231

Technical inquiries concerning this communication should be directed to



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Kenneth J. Ramsey, (703) 308-2324 (voice), (703) 746-4832 (fax).

A handwritten signature in black ink, appearing to read "Kenneth J. Ramsey". The signature is written in a cursive, flowing style.

Kenneth J. Ramsey  
Primary Examiner  
Art Unit 2879